

ESTTA Tracking number: **ESTTA466604**

Filing date: **04/11/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	The Hackett Group, Inc.		
Entity	Corporation	Citizenship	Florida
Address	1001 Brickell Bay Drive Suite 3000 Miami, FL 33131 UNITED STATES		

Attorney information	John Cyril Malloy, III Malloy & Malloy, P.L. 2800 S.W. Third Avenue Miami, FL 33129 UNITED STATES jcmalloy@malloylaw.com, fferreiro@malloylaw.com, litigation@malloylaw.com Phone:305-858-8000
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Registration Subject to Cancellation

Registration No	3878276	Registration date	11/16/2010
Registrant	Hackett Consulting 861 Woodleaf Park Drive Mableton, GA 30126 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2008/06/02 First Use In Commerce: 2008/06/02
All goods and services in the class are cancelled, namely: Branding services, namely, consulting, development, management and marketing of brands for businesses

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3064697	Application Date	03/03/2003
Registration Date	03/07/2006	Foreign Priority Date	NONE
Word Mark	THE HACKETT GROUP		

Design Mark	THE HACKETT GROUP
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1992/10/00 First Use In Commerce: 1992/10/00 business consultation and analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes

U.S. Registration No.	3229134	Application Date	09/23/2005
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	HACKETT PERSPECTIVE		
Design Mark	HACKETT PERSPECTIVE		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2003/10/15 First Use In Commerce: 2003/10/15 newsletter featuring topics related to business consultation and analysis, including best practice analysis, survey results, case studies and management issues		

U.S. Application No.	85348187	Application Date	06/16/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HACKETTCONNECTOR		
Design Mark	HACKETTCONNECTOR		

Description of Mark	NONE
Goods/Services	Class 009. First use: web based tool used for the purpose of analyzing operational metrics and performance trends

U.S. Application No.	85348179	Application Date	06/16/2011
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	HACKETT PERFORMANCE EXCHANGE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 009. First use: web based tool used for the purpose of analyzing operational metrics and performance trends
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U.S. Application No.	85351273	Application Date	06/21/2011
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	THE HACKETT HIGHWAY
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 035. First use: business consultation services in the nature of best practices and benchmarking of business processes
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Attachments	76494209#TMSN.gif (1 page)(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Francisco J. Ferreiro/
Name	Francisco J. Ferreiro
Date	04/11/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 3,878,276
For the mark "HACKETT CONSULTING"

_____)	
THE HACKETT GROUP, INC.,)	
)	
Petitioner,)	
)	
vs.)	Cancellation No.
)	
HACKETT CONSULTING,)	
)	
Registrant.)	
_____)	

PETITION TO CANCEL

COMES NOW the Petitioner, the Hackett Group, Inc. ("Petitioner"), a Florida corporation, having its principal place of business at 1001 Brickell Bay Drive, Suite 3000, Miami, Florida 33131, and hereby petitions to cancel U.S. Registration No. 3,878,276 for "HACKETT CONSULTING" owned by Hackett Consulting ("Registrant"), a Georgia company having an address of 861 Woodleaf Park Drive, Mableton, Georgia, 30126. As set forth below, Petitioner believes that it is or will be damaged by Registration No. 3,878,276:

CLAIM UNDER SECTION 2(d)

1. The alleged trademark sought to be cancelled is Registration No. 3,878,276 for the alleged mark "HACKETT CONSULTING" for use in connection with "branding services, namely, consulting, development, management, and marketing of brands for

businesses", in International Class 35. Registrant's application was filed on December 12, 2009, registered on November 16, 2010, and claims June 2, 2008 as the date of first use in commerce.

2. Since long prior to Registrant's filing date and claimed date of first use in commerce, Petitioner and/or Petitioner's predecessor(s), adopted the trademarks "THE HACKETT GROUP" for use in connection with "business consultation and analysis services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes" and "HACKETT PERSPECTIVE" for use on "newsletters featuring topics related to business consultation and analysis" (collectively Petitioner's "HACKETT" Marks). Since their adoption, Petitioner has continuously used its "HACKETT" Marks in interstate commerce for and in connection with these goods and services and has not abandoned these marks.

3. Petitioner is also the owner of incontestable U.S. Trademark Registration No. 3,064,697 for "THE HACKETT GROUP" for use in connection with "business consultation and analysis services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes" in International Class 035; and U.S. Trademark Registration No. 3,229,134 for "HACKETT PERSPECTIVE" for use on "newsletters featuring topics related to business consultation and analysis, including best practice analysis, survey results, case studies, and

management issues" in International Class 16. See Exhibit A. These registrations are valid and have not been abandoned.

4. On June 16, 2011, Petitioner filed two applications with the United States Patent and Trademark Office ("PTO"), namely, application Serial No. 85/348,187 for "HACKETTCONNECTOR" for use in connection with "web based tools used for the purpose of analyzing operational metrics and performance trends" in International Class 009 and application Serial No. 85/348,179 for "HACKETT PERFORMANCE EXCHANGE" for use in connection with "web based tools used for the purpose of analyzing operational metrics and performance trends" in International Class 009. On June 21, 2011, Petitioner filed an additional application (Serial No. 85/351,273) to register "THE HACKETT HIGHWAY" for use in connection with "business consultation services in the nature of best practices and benchmarking of business processes" in International Class 035 (collectively "Petitioner's Applications"). See Exhibit B.

5. On October 10, 2011, the Examining Attorney assigned to Petitioner's Applications issued Office Actions for each of Petitioner's Applications setting forth Section 2(d) refusals prefaced on the Registrant's mark.

6. Petitioner has expended considerable time, money, and effort in promoting its services under its "HACKETT" Marks. Throughout this time, the strength of Petitioner's "HACKETT" Marks has grown, such that Petitioner has established exceedingly

valuable goodwill in its "HACKETT" Marks.

7. By virtue of long and continuous use, and long prior to the acts of Registrant complained of herein, the "HACKETT" Marks developed a secondary meaning and significance, and have been readily recognizable, by the public and the trade, as a designation associated exclusively with Plaintiff's goods and services, and have become distinctive and famous.

8. Petitioner's "HACKETT" Marks have been used and promoted together in such a manner as to create public recognition not only of the individual marks but, also, as to the common, recognizable family mark, feature, or characteristic "HACKETT", so as to create a "HACKETT" family of marks associated with Petitioner and Petitioner's goods and services.

9. The Registrant's "HACKETT CONSULTING" mark is highly similar to Petitioner's "HACKETT" Marks.

10. The services identified in Registration No. 3,878,276 are substantially related to the goods and services offered by Petitioner in connection with its "HACKETT" Marks.

11. Upon information and belief, Registrant's services would be sold or offered for sale to the same consumers as Petitioner's goods and services.

12. Upon information and belief, there is a likelihood of confusion between Petitioner's "HACKETT" Marks when used on its goods and services and Registrant's "HACKETT CONSULTING" mark when

used on the services set forth in Registration No. 3,878,276.

13. If Registrant is permitted to keep its registration for "HACKETT CONSULTING" there will be a continued likelihood of confusion, mistake, and deception among the consuming public and the trade, all in violation of §2(d) of the Lanham Act, 15 U.S.C. §1052(d).

WHEREFORE, Petitioner prays that this Petition to Cancel be granted and that the aforesaid Registration No. 3,878,276 for the mark "HACKETT CONSULTING" be cancelled and removed from the Federal Registry.

An electronic copy of this Petition to Cancel and the fee required in 37 C.F.R. §2.6(a)(16) are enclosed herewith.

Respectfully submitted,

Dated: April 11, 2012

By: /Francisco J. Ferreiro/
John Cyril Malloy, III
Florida Bar No. 964,220
jcmalloy@malloylaw.com
Peter A. Matos
Florida Bar No. 992,879
pmatos@malloylaw.com
Francisco J. Ferreiro
Florida Bar No. 37,464
fferreiro@malloylaw.com
MALLOY & MALLOY, P.L.
Attorneys for Petitioner
2800 S.W. Third Avenue
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008

CERTIFICATE OF FILING

I HEREBY CERTIFY that the foregoing document was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board, web site, www.uspto.gov, this 11th day of April 2012.

By: Francisco J. Ferreiro/
Francisco J. Ferreiro

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on the following by mailing said copy on April 11, 2012, via First Class Mail, postage prepaid to:

Hackett Consulting
861 Woodleaf Park Drive
Mableton, Georgia 30126

By: Francisco J. Ferreiro/
Francisco J. Ferreiro

EXHIBIT A



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Typed Drawing**Word Mark** THE HACKETT GROUP
Goods and Services IC 035. US 100 101 102. G & S: business consultation and analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes. FIRST USE: 19921000. FIRST USE IN COMMERCE: 19921000

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76494209

Filing Date March 3, 2003

Filing Basis 1A

Original Filing Basis 1A

Published for December 13, 2005
Opposition
Registration Number 3064697

Registration Date March 7, 2006

Owner (REGISTRANT) Answerthink, Inc. CORPORATION FLORIDA 1001 Brickell Bay Drive, Suite 3000 Miami FLORIDA 33131

 (LAST LISTED OWNER) THE **HACKETT GROUP**, INC. CORPORATION FLORIDA 1001 BRICKELL BAY DRIVE, SUITE 3000 MIAMI FLORIDA 33131

Assignment Recorded ASSIGNMENT RECORDED

**Attorney of
Record** John Cyril Malloy, III

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GROUP" APART FROM THE MARK AS SHOWN

**Type of
Mark** SERVICE MARK

Register PRINCIPAL-2(F)

**Affidavit
Text** SECT 15. SECT 8 (6-YR).

**Live/Dead
Indicator** LIVE

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HACKETT PERSPECTIVE**Word Mark** HACKETT PERSPECTIVE**Goods and Services** IC 016. US 002 005 022 023 029 037 038 050. G & S: newsletter featuring topics related to business consultation and analysis, including best practice analysis, survey results, case studies and management issues. FIRST USE: 20031015. FIRST USE IN COMMERCE: 20031015**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 78719630**Filing Date** September 23, 2005**Filing Basis** 1A**Original Filing Basis** 1A**Published for** January 30, 2007**Opposition****Registration Number** 3229134**Registration**

Date April 17, 2007
Owner (REGISTRANT) Answerthink, Inc. CORPORATION FLORIDA Suite 3000 1001 Brickell Bay Drive Miami FLORIDA 33131
(LAST LISTED OWNER) THE **HACKETT GROUP**, INC. CORPORATION FLORIDA 1001 BRICKELL BAY DRIVE, SUITE 3000 MIAMI FLORIDA 33131
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Andrew W. Ransom
Prior Registrations 2854546;2937236;3064697
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PERSPECTIVE" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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EXHIBIT B



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HACKETTCONNECTOR**Word Mark** HACKETTCONNECTOR**Goods and Services** IC 009. US 021 023 026 036 038. G & S: web based tool used for the purpose of analyzing operational metrics and performance trends**Standard Characters**
Claimed**Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85348187**Filing Date** June 16, 2011**Filing Basis** 1B**Original Filing Basis** 1B**Owner** (APPLICANT) The Hackett Group, Inc. CORPORATION FLORIDA 1001 Brickell Bay Dr., Ste. 3000 Miami FLORIDA 33131**Attorney of Record** John Cyril Malloy, III**Type of Mark** TRADEMARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE

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[TARR Status](#) [ASSIGN Status](#) [TDR](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)HACKETT PERFORMANCE
EXCHANGE

Word Mark HACKETT PERFORMANCE EXCHANGE

Goods and Services IC 009. US 021 023 026 036 038. G & S: web based tool used for the purpose of analyzing operational metrics and performance trends

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85348179

Filing Date June 16, 2011

Filing Basis 1B

Original Filing Basis 1B

Owner (APPLICANT) The Hackett Group, Inc. CORPORATION FLORIDA 1001 Brickell Bay Dr., Ste. 3000 Miami FLORIDA 33131

Attorney of Record John Cyril Malloy, III

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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THE HACKETT HIGHWAY**Word Mark** THE HACKETT HIGHWAY**Goods and Services** IC 035. US 100 101 102. G & S: business consultation services in the nature of best practices and benchmarking of business processes**Standard Characters**
Claimed**Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85351273**Filing Date** June 21, 2011**Filing Basis** 1B**Original Filing Basis** 1B**Owner** (APPLICANT) The **Hackett Group**, Inc. CORPORATION FLORIDA 1001 Brickell Bay Dr., Ste. 3000 Miami FLORIDA 33131**Attorney of Record** John Cyril Malloy, III**Type of Mark** SERVICE MARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DOC](#) [SEARCH OG](#) [Top](#) [HELP](#) [PREV LIST](#) [CURR LIST](#)
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